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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,242	01/29/2004	William A. Margiloff	E03.003/U	4775

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EXAMINER	
VANDERHORST, MARIA VICTORIA	
ART UNIT	PAPER NUMBER
4194	
MAIL DATE	DELIVERY MODE
03/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/767,242	MARGILOFF ET AL.	
	Examiner	Art Unit	
	VICTORIA VANDERHORST	4194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *12-35* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *03/15/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claim 1-11, drawn to Payment, classified in class 705, subclass 40.

   II. Claim 12-20, drawn to Bidding, classified in class 705, subclass 37.

   III. Claim 21-29, drawn to Incentive/Advertisement, classified in class 705, subclass 14.

   IV. Claim 30-35, drawn to Generating Database or Data Structure, classified in class 707, subclass 102.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as bidding. See MPEP § 806.05(d).

3. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in

scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination III has separate utility such as advertising. See MPEP § 806.05(d).

4. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination IV has separate utility such as Generating Database or Data Structure. See MPEP § 806.05(d).

5. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as bidding. See MPEP § 806.05(d).

6. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as bidding. See MPEP § 806.05(d).

7. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination IV has separate utility such as Generating Database or Data Structure. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

8. Restriction is proper because to facilitate the prosecution of the present invention the claims can be grouped in different class/ subclass classification (705/40, 705/37,705/14, 707/102), which requires a different search strategy. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions

have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

9. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Election/Restrictions

Applicant's election of claims 1-11 in the reply filed on Mar 5, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 12-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on March 5/2008.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1-4 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 6,907,566 McElfresh et al.

As to claim 1, McElfresh discloses a method, comprising:

determining payment information associated with a plurality of graphical advertisements to be electronically provided to users via a communication network, the advertisements being associated with a number of different advertisers (**McElfresh discloses a system to place graphical objects such as advertisements (ads) on a webpage ,Abstract**);

determining user response information for each advertisement (**Col 2:39-44**), the user response information being associated with an action taken by a user in response to an advertisement (**Col 2:39-44, Col 3:1-5**); and

selecting at least one of the advertisements based on the payment information and the user response information (**McElfresh discloses that his system has a database of advertisements that contains data about each ad, such as price per impression, price-per-click, etc, Col 6:57-68. Furthermore, McElfresh' system calculates through different methods the cost that the advertiser pays to display an ad in a webpage, Col. 5:66-67, Col. 6:1-15, the server uses the performance data to derive a prioritized arrangement of the objects (ads) when the webpage is rendered on the web browser, Abstract**).

As to claim 2, McElfresh discloses a system wherein the selection of the advertisement is not based on information received from a remote user device (**Col. 5:15-27**).

As to claim 3, McElfresh discloses a system wherein the communication network is the Internet (**Col. 2:56-61**), the action by the user is clicking on the advertisement, the payment information is a cost-per-click value, and the user response information is a click-through-rate value (**Col. 2 56-61, Col 3:1-19**).

As to claim 4, McElfresh discloses a system wherein said selecting comprises: selecting the advertisement based on the cost-per-click value multiplied by the click-through-rate value (**Col. 3:1-5, Col 5:15-27**).

As to claim 6, McElfresh discloses a system that displays the selected advertisement to a user (**Col. 5:66-67, Col. 6:1-15**).

As to claim 7, McElfresh discloses a system that transmitting information about the advertisement to a remote user device (**Claim 9 of current reference**).

As to claim 8, McElfresh discloses a system wherein the remote user device locally determines when the advertisement will be displayed (**Col. 11:41-68, Col. 12:1-10**).

As to claim 9, McElfresh discloses a system wherein the determination by the remote user device is based on contextual information associated with information being accessed by a user (**McElfresh teaches that his system stores context information (user information) that later is used to optimize events, Col 2:56-68, Col. 3:1-5, Col. 12:1-10. Furthermore, McElfresh' system uses "cookies" to store context information, Col. 3:20-45**).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claim 5, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 6,907,566 McElfresh et al in view of PG PUB 20040103024 Patel at al.

As to claim 5, McElfresh discloses a method for placement or rendering of graphical objects (advertisements) in a webpage as applied in the rejection of claim 1, further McElfresh' system discloses that the communication network is the Internet (**Col 12:40-41**), but McElfresh does not teach in his system that the action by the user is a purchase, the payment information is a cost-per-action value, and the user response information represents a user purchase frequency.

However, Patel teaches in his system that the action by the user is a purchase, the payment information is a cost-per-action value, and the user response information represents a user purchase frequency **(paragraphs [0025-0034]).**

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Patel's teaching into the McElfresh' method or system, in order to provide another way for advertisers to pay publishers, allowing the advertisers to choose the model that is more convenient for them.

As to claim 10, McElfresh discloses an apparatus, comprising:

a processor (**Claim 9 of McElfresh' reference**); and

a storage device in communication with said processor and storing instructions adapted to be executed by said processor to (**Claim 10 of McElfresh' reference**):

determine payment information associated with a plurality of graphical advertisements to be electronically provided to users via a communication network (**Claims 10 and 11 of McElfresh' reference, Col. 12:30-41**), the advertisements being associated with a number of different advertisers (**Col. 12:30-41, Claims 1 and 9 of McElfresh' reference**);

select at least one of the advertisements based on the payment information and the user response information (**McElfresh discloses that his system has a database of advertisements that contains data about each ad, such as price per impression, price-per-click, etc, Col 6:57-68. Furthermore, McElfresh' system calculates through different methods the cost that the advertiser pays to display**

an ad in a webpage, Col. 5:66-67, Col. 6:1-15, the server uses the performance data to derive a prioritized arrangement of the objects (ads) when the webpage is rendered on the web browser, Abstract),

but McElfresh does not teach in his system that it determines user response information for each advertisement, then the user response information being associated with an action taken by a user in response to an advertisement.

However, Patel teaches in his system that his system determines user response information for each advertisement, then the user response information being associated with an action taken by a user in response to an advertisement (**paragraphs [0025-0034]**).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Patel's teaching into the McElfresh' method or system, in order to provide another way for advertisers to pay publishers, allowing the advertisers to choose the model that is more convenient for them.

As to claim 11, McElfresh discloses a medium storing instructions adapted to be executed by a processor to perform a method, said method comprising:

determining payment information associated with a plurality of graphical advertisements to be electronically provided to users via a communication network (**Claims 10 and 11 of McElfresh' reference, Col. 12:30-41**), the advertisements being associated with a number of different advertisers (**Col. 12:30-41, Claims 1 and 9 of McElfresh' reference**);

selecting at least one of the advertisements based on the payment information and the user response information (**McElfresh discloses that his system has a database of advertisements that contains data about each ad, such as price per impression, price-per-click, etc, Col 6:57-68. Furthermore, McElfresh' system calculates through different methods the cost that the advertiser pays to display an ad in a webpage, Col. 5:66-67, Col. 6:1-15, the server uses the performance data to derive a prioritized arrangement of the objects (ads) when the webpage is rendered on the web browser, Abstract**),

but McElfresh does not teach in his system that it determines user response information for each advertisement, then the user response information being associated with an action taken by a user in response to an advertisement (**paragraphs [0025-0034]).**

However, Patel teaches in his system that his system determines user response information for each advertisement, then the user response information being associated with an action taken by a user in response to an advertisement (**paragraphs [0025-0034]**).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Patel's teaching into the McElfresh' method or system, in order to provide another way for advertisers to pay publishers, allowing the advertisers to choose the model that is more convenient for them.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA VANDERHORST whose telephone number is (571)270-3604. The examiner can normally be reached on Monday through Friday 7:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Maria Victoria Vanderhorst/
Examiner, Art Unit 4194
/V. V./

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